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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/530,431	09/13/2005	Hitoshi Murakami	270142US0PCT	4995
22850 7590 09/17/2008 OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314				
EXAMINER ROGERS, JUNE MARIE				
ART UNIT		PAPER NUMBER		
1612				
NOTIFICATION DATE		DELIVERY MODE		
09/17/2008		ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary

Application No.

10/530,431

Applicant(s)

MURAKAMI ET AL.

Examiner

JUNE ROGERS

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SF 298)
Paper No(s)/Mail Date 4/26/2005
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date ____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: ____

DETAILED ACTION

Claim Rejections - 35 USC § 112

LACK OF WRITTEN DESCRIPTION UNDER 35 U.S.C. § 112, FIRST PARAGRAPH:

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 2 -10 are rejected under 35 U.S.C. § 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The description requirement of the patent statute requires a description of an invention, not an indication of a result that one might achieve if one made that invention. See, e.g. In re Wilder, 22 USPQ 369, 372-3 (Fed. Cir. 1984). (Holding that a claim was not adequately described because the specification did "little more than outline goals appellants hope the claimed invention achieve and the problems the invention will hopefully ameliorate.")

Mere indistinct terms (such as "nutritional components" "anti-fatigue components"; "taste-improving components"; "coloring matters"; "nitrogen-containing compounds"; "nucleic acid-related compounds"; and mineral components" and "extract" used herein), however may not suffice to meet the written description requirement. This is particularly true when a compound is claimed in purely functional terms. See Univ. of Rochester v. G.D. Searle, 69

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USPQ2d 1886, 1892 (CAFC 2004), stating:

The appearance of mere indistinct words in a specification or a claim, even an original claim, does not necessarily satisfy that requirement. A description of an anti-inflammatory steroid, i.e., a steroid (a generic structural term) described even in terms of its functioning of lessening inflammation of tissues fails to distinguish any steroid from others having the same activity or function. A description of what a material does, rather than of what it is, usually does not suffice.... The disclosure must allow one skilled in the art to visualize or recognize the identity of the subject matter purportedly described. (Emphasis added).

A description of a chemical genus will usually comprise a recitation of structural features common to the members of the genus, which features constitute a substantial portion of the genus. See University of California v. Eli Lilly and Co., 43 USPQ2d 1398, 1406 (Fed. Cir. 1997). This is analogous to enablement of a genus under section 112, P 1, by showing the enablement of a representative number of species within the genus.

A chemical genus can be adequately described if the disclosure presents a sufficient number of representative species that encompass the genus. If the genus has substantial variance, the disclosure must describe a sufficient number of species to reflect the variation within that genus. See MPEP 2163. Although the MPEP does not specifically define what constitutes a representative number of species, the courts have indicated what does not constitute the same. See, e.g., In re Gostelli, 10 USPQ2d 1614, 1618 (Fed. Cir. 1989), holding that the disclosure of two chemical compounds within a subgenus did not adequately describe such subgenus.

The MPEP lists factors that can be used to determine if sufficient evidence of possession has been furnished in the disclosure of the Application. These include the level of skill and knowledge in the art, partial structure, physical

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and/or chemical properties, functional characteristics alone or coupled with a known or disclosed correlation between structure and function, and the method of making the claimed invention. Disclosure of any combination of such identifying characteristics that distinguish the claimed invention from other materials and would lead one of skill in the art to the conclusion that the applicant was in possession of the claimed species is sufficient. MPEP 2163.

Here, the specification does not provide a reasonably representative disclosure of useful examples of these poorly defined, functionally characterized classes of ingredients generally, a potentially huge genus inclusive of many different species having widely divergent structures and functions.

Note also that the term is not adequately defined by the specification, for the reasons outlined in the indefiniteness rejection See In re Wohnseidler, 137 USPQ 336 (C.C.P.A. 1963). Without knowing the particular extractions used, the mere invocation of the word "extract" is not an adequate written description of any particular product. Even the more narrow recitations of some of the dependent claims, e.g., "enzymatic hydrolysis" in claim 7, are insufficient to provide an adequate written description since they don't specify any particular enzymes, nor any particular processing conditions (temperature, time of digestion, etc.

Claim Rejections - 35 USC § 112 2nd Paragraph

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-10 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 9 provides for the use of koji mold, but, since the claim does not set forth any steps involved in the method/process, it is unclear what method/process applicant is intending to encompass. A claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced.

Regarding claim 10, the phrase "such as" renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

Additionally, the phrase "and the like", renders the claim(s) indefinite because the claim(s) include(s) elements not actually disclosed (those encompassed by "or the like"), thereby rendering the scope of the claim(s) unascertainable. See MPEP § 2173.05(d).

Regarding the term "extract", an "extract" is characterize a product whose identity will be determined by the specific extraction conditions used, including the temperature, solvent, and other processing parameters. See In re Wohnseidler, 137 USPQ 336 (C.C.P.A. 1963). Here, the specification defines the term "extract" in the most general of terms, i.e., it states at the second paragraph of page 6 that "the extract may be obtained by an ordinary method, or an extract

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produced by a method different from an ordinary method may be used as long as it has a similar composition.”

Claim Rejections - 35 USC § 102 (b)

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-10 are rejected under 35 U.S.C. 102(b) as being anticipated by Mizutani et al JP2002-298905. Mizutani et al discloses food compositions comprising extracts of bonito and tuna (see [0011]). (Note that applicant appears to admit on page 7 of the instant specification that the extract of Mizutani is the preferred extract of claim 10).

Claims 1-8 are rejected under 35 U.S.C. 102(b) as being anticipated by Togashi et al. JP 2000-210056.

Togashi et al. discloses food compositions comprising extracts of bonito and tuna (see claims 1-3) and diluted with water (see [0041]).

Claim Rejections - 35 USC § 102(a)

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

Claims 1-9 are rejected under 35 U.S.C. 102(a) as being anticipated by Matahira et al. USP 6,855,727.

Matahira et al. compositions comprising an extract of bonita and tuna (see "anserine" col. 2, 56-57, and col. 4, example 1). Matahira teaches said extract is added to food and drink (col. 4, line 1) and exemplifies a composition comprising said extract with d-ribose, taurine, vitamin C, sugar, perfumes and preservatives and minerals (col. 6, table 1 and table 2).

Statutory (101) Double Patenting

A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

Claims 1-4 are provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claim 1-4 of copending Application No. 11/517461.

This is a provisional double patenting rejection since the conflicting claims have

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not in fact been patented. Insofar as the examiner can determine, the claims in each case are drawn to substantially the subject matter.

Nonstatutory Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 6-10 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 5-12 of copending Application No. 11/517461. Although the conflicting claims are not identical, they are not patentably distinct from each other because the instant Application recites bonito fish/ and or tuna fish and the conflicting claims only recite bonito, it would have been obvious to select bonito from the options of

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bonito and/or tuna. Additionally, Application No. 11/517461 recites different exaction methods in claims 7, 9, 10, and 11, both applications are drawn to substantially the same compositions comprising a bonito extract and therefore it would be obvious to use known methods of extraction to obtain said extract.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Conclusion

No claims allowed.

Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JUNE ROGERS whose telephone number is (571)270-3497. The examiner can normally be reached on M-F 9-6pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fred Krass can be reached on 571-272-0580. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Juné M. Rogers

/Frederick Krass/
Supervisory Patent Examiner, Art Unit 1612